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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/959,748	10/28/97	CLEMMER	PD-30-3986DI

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HM12/1026

EXAMINER
PRYOR, A

ART UNIT	PAPER NUMBER
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1616

13

DATE MAILED: 10/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

2,3 obj
5-8

Rej
1,9

4, 19, 20
A110

Office Action Summary

Application No.
08/959,748

Applicant(s)
Clemmer et al

Examiner
Alton Pryor

Group Art Unit
1616



☒ Responsive to communication(s) filed on Feb 10, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-9, 19, and 20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-7, 9, 19, and 20 is/are allowed.

☒ Claim(s) 8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Non-Final Action on the Merits

Action Summary

Claims 1-9,19,20 are pending. Claim 8 is rejected. Claims 1-7,9,19,20 are allowable.

I. Rejections of claims 1-4,6-9 under 35 U.S.C. 102(a,e) will not be maintained in light of amendment filed 2/18/99. Applicants submitted a Declaration to overcome the rejection.

II. Double Patenting Rejection will not be maintained in light of amendment filed 2/18/99. Applicants submitted a Terminal Disclaimer to overcome the rejection.

III. Claim Objection will not be maintained in light of amendment filed 2/18/99.

Applicants have provided a Declaration to overcome rejection of claim 5. Applicants are correct in that Examiner made an error in his objection of claim 20.

IV. Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections under 35 U.S.C. 112, 1st paragraph

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 8 applicants claim oxyfluoride as a catalyst. However, in the specification oxyhalides are disclosed as catalysts. Although oxyfluoride is a species in the oxyhalide genus, how would one having ordinary skill in the art know, based on the applicants' specification, that oxyfluoride is the

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preferred or best oxyhalide to use in instant process. In re Ruschig 154 USPQ 118, CCPA 1967.

Also, in claim 8, applicants claim Zn as a catalyst. Zn is not describe in the specification as a catalyst. However, Zn compounds (zinc oxides) and Zn complexes (e.g. Zn on Al or Mg) are disclosed in the instant specification.

V. Examiner acknowledges applicants' request for an interference. The examiner will subject instant application into interference status once the above matters are clarified or corrected.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton Pryor whose telephone number is (703) 308-4691. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

ANP

10/22/99



S. MARK CLARDY
PATENT EXAMINER
GROUP 1200-1616

Acting SRE